

ESTTA Tracking number: **ESTTA294245**

Filing date: **07/08/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92048654
Party	Defendant TOB International Marketing Corp.
Correspondence Address	Baila H. Celedonia Cowan Liebowitz & Latman 1133 Avenue of the Americas New York, NY 10036 UNITED STATES bhc@cll.com
Submission	Other Motions/Papers
Filer's Name	Baila H. Celedonia
Filer's e-mail	bhc@cll.com
Signature	/Baila H. Celedonia/
Date	07/08/2009
Attachments	TOB Int'l Registrant's Response.pdf ( 7 pages )(187144 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

---

Waterford Wedgwood Plc,

Petitioner,

v.

TOB Int'l Marketing Corp.

Registrant,

---

Cancellation No. 92048654

**REGISTRANT'S RESPONSE TO PETITIONER'S OPPOSITION TO MOTION FOR  
DISMISSAL AND IN OPPOSITION TO PETITIONER'S MOTION TO SUSPEND  
PROCEEDINGS OR REOPEN TESTIMONY PERIOD**

Registrant responds to Petitioner's Opposition to Motion for Dismissal and Motion to Suspend Proceedings or Reopen Testimony Period ("Petitioner's Brief") on the following grounds.

**Factual Background**

The parties had negotiated a settlement agreement which Registrant, in good faith, signed December 3, 2008 (Exhibit A to Petitioner's Brief). The agreement was forwarded to counsel for Petitioner shortly thereafter. However, the agreement was not then signed by Petitioner and has still not been signed by Petitioner. On January 12, 2009, over a month after sending the agreement to counsel for Petitioner, counsel for Registrant inquired as to when she might expect to receive the fully executed agreement. The response that query was "[w]e hope to send you the agreement soon." This email exchange is attached as Exhibit A herein. Registrant's counsel did

not hear from Petitioner's counsel again, including with regard to any alleged difficulty he was having in having the agreement signed by Petitioner.

After waiting an additional four months from this last communication, Registrant served formal notice on Petitioner that it was withdrawing its offer of settlement (Exhibit D to Petitioner's Brief), as specifically provided in the agreement.

19. This Settlement Agreement may be executed in counterparts, and *when counterparts of this Settlement Agreement have been signed by all Parties, it shall constitute an agreement.*

By a motion on consent filed in October 2008, the Board had reset various deadlines, including Petitioner's 30-day Trial Period, which was reset to end on April 28, 2009. Petitioner never requested a further extension of time for its Trial Period.

#### Discussion

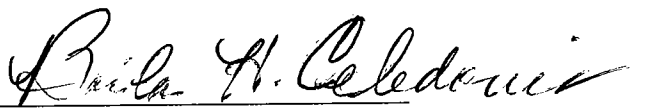
Only if a party's failure to take testimony during its previously-assigned testimony period was the result of "excusable neglect" under FRCP 6(b)(2) can such testimony period be reopened. However, Petitioner's purported reasons for its delay were entirely within its control. After the January 12, 2009 exchange of email referenced above, Petitioner's counsel never contacted Registrant's counsel informing her that he was having difficulty in getting the agreement signed by his client, nor did Petitioner request a consent to an extension of any of the deadlines in this Cancellation Petition. Neither did Petitioner seek a stay in these proceedings based on its bankruptcy, nor an extension of its time to take testimony. *Pumpkin, Ltd. v. Seed Corps*, 43 USPQ2d 1582 (TTAB 1997).

Also, under these facts, Petitioner cannot rely on the existence of a settlement agreement for its failure to submit testimony or request an extension of time to submit such testimony. By its very terms, the agreement did not constitute contract until all parties had signed. This

reservation is a crucial factor in determining if a contract exists between the parties.<sup>1</sup> *Atlanta-Fulton County Zoo, Inc. v. DePalma*, 45 USPQ2d 1858 (TTAB 1998). Rather, Petitioner assumed it did not need to do anything with respect to the deadlines in this Cancellation Action. This lack of action does not constitute excusable neglect.

For the foregoing reasons, Registrant's Motion for Dismissal for Failure to Take Testimony should be granted and Petitioner's Motion to Suspend Proceedings or Reopen Testimony Period be denied.

TOB INT'L MARKETING CORP.

By   
Baila H. Celedonia  
Attorney for Registrant  
Cowan, Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, New York 10036  
Telephone: 212 790-9200  
Facsimile: 212 575-0671

Date: July 8, 2009

---

<sup>1</sup> Under New York common law of contracts "it is the intent of the parties that will determine the time of contract formation." *Winston v. Mediafare Entertainment Corp.*, 777 F.2d 78, 80 (2d Cir. 1985). Parties to an agreement have the freedom to determine exactly when the agreement becomes binding, whether it be upon oral acknowledgement of the negotiated terms or upon full execution of a final document. *Id.* See also, *Burgess v. Morse*, 387 F. Supp. 2d 246, 251 (WDNY 2005)

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing REGISTRANT'S RESPONSE TO PETITIONER'S OPPOSITION TO MOTION FOR DISMISSAL AND IN OPPOSITION TO PETITIONER'S MOTION TO SUSPEND PROCEEDINGS OR REOPEN TESTIMONY PERIOD was served this 8<sup>th</sup> day of July, 2009 by first-class mail, postage prepaid, on Bassam N. Ibrahim, Buchanan Ingersoll & Rooney, PC, 1737 King Street, Alexandria, Virginia 22314-2727.

  
\_\_\_\_\_  
Kristine Natale

***Exhibit A***

## Celedonia, Baila

---

**From:** Ibrahim, Bassam [bassam.ibrahim@bipc.com]  
**Sent:** Monday, January 12, 2009 4:14 PM  
**To:** Celedonia, Baila  
**Subject:** RE: VINTAGE / VINTAGE MODERN Opposition

Dear Baila

We hope to send you the agreement soon-

Regards,

Sam

*Bassam N. Ibrahim*

Intellectual Property Group Practice Leader  
Buchanan Ingersoll & Rooney PC  
1737 King Street, Suite 500  
Alexandria, VA 22314-2727  
Phone: 703-838-6584  
Fax: 703-836-2021  
E-mail: [bassam.ibrahim@bipc.com](mailto:bassam.ibrahim@bipc.com)

This message contains information that may be confidential and legally exempt from disclosure. It is intended exclusively for the addressee(s) of this message. If you are not an addressee of this message, please delete the message from your computer. We do not waive any attorney client privilege or work product immunity by the transmission of this message. Thank you.

---

**From:** Celedonia, Baila [mailto:BHC@cjl.com]  
**Sent:** Monday, January 12, 2009 4:04 PM  
**To:** Ibrahim, Bassam  
**Subject:** VINTAGE / VINTAGE MODERN Opposition

Dear Sam,

We sent you the settlement agreement signed by our client last month. When do you expect to have the agreement signed by your client and a fully executed agreement returned to me? Until we receive it, we cannot withdraw the objected to application, etc.

Best regards,  
Baila

**Baila H. Celedonia**  
Cowan, Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, NY 10036  
212 790-9203 (direct)  
212 575-0671 (fax)  
[bhc@cjl.com](mailto:bhc@cjl.com)

\*\*\*\*\*

## IRS CIRCULAR 230 DISCLOSURE

Under regulations issued by the U.S. Treasury, to the extent that tax advice is contained in this communication (or any attachment or enclosure hereto), you are advised that such tax advice is not intended or written to be used, and cannot be used by you, or any other party to whom this correspondence is shown, for the purpose of: (i) avoiding penalties under the Internal Revenue Code, or (ii) promoting, marketing or recommending the tax advice addressed herein to any other party.

This message is intended only for the designated recipient(s). It may contain confidential or proprietary information and may be subject to the attorney-client privilege or other confidentiality protections. If you are not a designated recipient, you may not review, copy or distribute this message. If you receive this in error, please notify the sender by reply e-mail and delete this message. Thank you.

\*\*\*\*\*

**TAX ADVICE DISCLAIMER:** Any federal tax advice contained in this communication (including attachments) was not intended or written to be used, and it cannot be used, by you for the purpose of (1) avoiding any penalty that may be imposed by the Internal Revenue Service or (2) promoting, marketing or recommending to another party any transaction or matter addressed herein. If you would like such advice, please contact us.

Above email is for intended recipient only and may be confidential and protected by attorney/client privilege.

If you are not the intended recipient, please advise the sender immediately.

Unauthorized use or distribution is prohibited and may be unlawful.